

RESPONSE

A. Status of the Claims

Claims 26-56 were pending at the time of the Restriction Requirement, with claims 1-25 having been canceled in the Preliminary Amendment filed with the application. Claims 46-56 are provisionally withdrawn from consideration at this time in view of the election of the Group I invention made below in response to the Restriction Requirement. Therefore, claims 26-45 are presently under consideration in the case. Further, if Applicants' traversal of the Restriction Requirement is accepted, then claims 46-56 are also under consideration.

B. Response to Restriction Requirement

In response to the restriction requirement, Applicants elect, *with traverse*, to prosecute the Group I invention, as exemplified by claims 26-45, drawn to a process.

Applicants contend, without prejudice, that both Groups I and II, as set forth in current claims 26-56, should be examined in the instant application, for the reasons below.

The restriction requirement argues that Groups I and II do not relate to a single general inventive concept as required by PCT Rule 13.1, because they lack the same or corresponding special technical features as required by PCT Rule 13.2. This is not the case.

As an initial point, Applicants point out that the Restriction Requirement completely fails to meet the USPTO's burden of establishing why restriction between the claims is proper. Therefore, the Restriction Requirement is insufficient as a matter of law and procedure, and no further argument by Applicants is needed. The Restriction Requirement contains merely bald statements and does not explain why the listed inventions would not share at least one special technical feature. Additionally, the Examiner does not base the Restriction Requirement on any prior art document which would confirm that a special technical feature does not exist between the claims. Despite the facial inadequacies of the Restriction Requirement, which independently

compel that it be withdrawn, Applicants set for the following additional reasons why the Restriction Requirement is improper.

The inventions listed as Groups I and II relate to a single general inventive concept under PCT Rule 13.1 because they share at least one special technical feature that defines a contribution over the prior art (PCT rule 13.2). The mere fact that an international application contains claims of different categories is in itself no reason for objection on the grounds of lack of unity of the invention (Chapter VII, 5 of the PCT Search Guidelines, PCT Gazette No. 30/1992, Sec. IV; No. 29/1993, Sec. IV).

The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that define in each claim a contribution which each of the inventions makes over the prior art (PCT Guidelines 10.01). Additionally, whether or not any particular technical feature makes a “contribution” over the prior art, and therefore constitutes a “special technical feature,” has to be considered with respect to novelty and inventive step (PCT Guidelines 10.02). Only then is it possible to decide whether or not a common special technical feature within the meaning of Rule 13.1 PCT and Rule 13.2 PCT exists for different inventions. Where, as in this case, there is no showing in the Restriction Requirement that a special technical feature of the process or product claims lacks novelty and/or non-obviousness, then it is not proper to state that there is no special technical feature linking the claims.

The current claim set comprises at least one common inventive step in that all the claims address the problem of treating lenses on a second main face, said treatment including a treatment with energetic and/or reactive species, while a first main surface bears at least one thin organic or inorganic external layer. The latter may actually be altered in the course of the treatment step of the second face of the lens. This problem is solved by the deposition of a

protective temporary layer onto the thin external organic or inorganic layer of said first face of the lens.

The process of claim 26 and its dependents (“Group I”) comprise the following steps:

- providing an ophthalmic lens comprising a first side comprising a thin external organic or inorganic layer, and a second side,
- depositing a temporary protective layer onto said thin external organic or inorganic layer
- treating the second side with an energetic and/or reactive species resulting in surface physical attack and/or chemical modification.

Group II comprises two independent claims (claims 46 and 48). These claims are dedicated to a lens comprising on one face a thin external organic or inorganic layer coated with a temporary protective layer. Thus, the object of the Group II claims can be construed to be an intermediate product formed during the process according to claim 26.

A special technical feature common to each “Group” is a lens comprising on one face a thin external organic or inorganic layer coated with a temporary protective layer. The subject matters of an application relating to a process and to a new intermediate product are integrated into a single overall concept when these inventions are technically interconnected and are all oriented towards obtaining the same end-product.

In view of the above, a technical relationship exists between Groups I and II involving special technical features, since lenses according to claims 46 and 48 have been especially devised to carry out the process according to claim 26. Moreover, the claimed process and lenses contribute to obtaining the same end-product and solve the same technical problem.

In view of the failure of the Restriction Requirement to cite any reference, much less any reference teaching this common technical relationship between the claims, there is no evidence

of record to dispute that there is a common inventive feature between the claims, and the Restriction Requirement must be withdrawn.

In view of the above, the “inventions” set forth in Groups I and II have a common inventive concept as required by PCT Rule 13.2, and Applicants request withdrawal of the Restriction Requirement and examination of all pending claims in the present case.

Additionally, examination of all of the claims of Groups I and II should be performed together because a corresponding search would not present a “serious burden” on the examiner. MPEP § 803 (“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions”). Given the fact that there is a common inventive concept between the all of the present claims, Applicants submit that there is no “serious burden” in examining the Groups I and II inventions together in this case. Further, the examiner has provided no evidence of any serious burden.

In traversing the Restriction Requirement on the grounds set forth above, Applicants specifically take no position with regard to whether any sets of the present claims or any individual present claims are or are not patentably distinct from any other set of claims or individual claim. Rather, Applicants argue without acquiescence that, under the circumstances of this case and in view of the applicable PCT rules and statements of the MPEP, the stated restriction is not proper, whether those claims are patentably distinct or not. Such arguments do not create an estoppel against Applicants and are not an admission that the restricted Groups are either patentably distinct or patentably indistinct from one another.

In view of the above, Applicants request withdrawal of the Restriction Requirement and examination of all pending claims in the present case.

C. Conclusion

Applicants believe this paper to be a full and complete response to the Restriction Requirement dated January 17, 2007. Applicants respectfully request favorable consideration of this case in view of the above comments and amendments. Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3035.

Respectfully submitted,



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